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Applicant: Desimone et al.
Appl. No.: 10/583,570
International Filing Date: December 20, 2004
Title: Methods For Fabricating Isolated Micro-And Nano-Structures Using Soft Or Imprint Lithography
Attorney Docket: 035052/338899
Pub. No.: US 2009/0028910 A1
Pub. Date: January 29, 2009

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on March 30, 2009, for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the publication misstates the dependency of claim 60 from claim 59 rather than claim 57.

37 CFR 1.221 (b) is applicable:

“only when the Office makes a **material mistake** which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable” (*emphasis added*).

A material mistake must affect the public’s ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.¹

The error noted by requestor with respect to failure to include the preliminary amendment in the publication is not an Office error. See 37 CFR 1.215(a). Applicant’s attention is further directed to MPEP 1130(B), which clearly states “failure to include an amendment is not an Office error . .

¹Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

. [a] request for corrected publication under 37 CFR 1.221(b) may result in a patent term adjustment reduction where the Office made only non-material errors.”

The requirements for inclusion of an amendment in a patent application publication are set forth in 37 C.F.R. § 1.215. Applicant did not file a copy of the application in compliance with the Office electronic filing systems requirements. See 37 CFR 1.215 and MPEP 1121.

Applicant is reminded of his duty to conduct a reasonable inquiry before filing a paper before the Office. See MPEP 410.

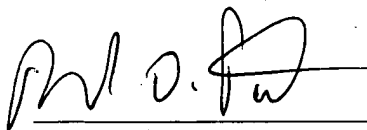
Applicants' request for a corrected patent application publication on March 30, 2009, may constitute a “failure to engage in reasonable efforts to conclude processing or examination of the application.” See 1.704(c). This determination will be made on or after a mailing of a Notice of Allowance.

It would greatly benefit the Office if **applicant did not provide copies of papers**, which were previously submitted and/or **a complete copy of the pre-grant publication**, as it unnecessarily increases the cost to the Office. See 37 CFR 1.4(b). A request for corrected publication need only point out what was printed incorrectly in the application, where the error occurs in the publication and where the correct text or drawing is found in the application papers. Marked up relevant copies of the applications papers and the pre-grant publication may facilitate processing of the request, where it is not readily apparent where the error occurs. If it is not clear why the error is a material error, further explanation may be warranted.

The applicant is advised that a “request for republication of an application previously published” may be filed under 37 CFR 1.221(a). Such a request for republication “must include a copy of the application compliance with the Office’s electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i).” If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, as a “Pre-Grant Publication”.

Inquiries relating to this matter may be directed to Michael Cygan at (571) 272-7700, or to the undersigned at (571) 272-7709.



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